

*C Comp.*

- b) a protein or peptide of SEQ ID NO:2 or 4 immobilized to a solid support; and
- c) instructions for use.

### REMARKS

Claims 6, 12, and 23-29 are pending. Claims 6, 12, and 23-29 are rejected. Claim 12 is amended. Support for new Claim 30 can be found in originally filed Claims 6 and 12, and on page 47, lines 8-16, of the Specification. Applicants note the withdrawal of the required species election set forth in Paper Number 7, dated February 14, 2002. Applicants appreciate the Examiner's willingness to reconsider this species election.

I. Rejection of Claim 12 under 35 U.S.C. §112, First Paragraph.

The Examiner rejected Claim 12 under 35 U.S.C. §112, first paragraph. The basis of this rejection is the recitation of "receptor". Claim 12 is canceled and the rejection is therefore moot as to this claim. New Claim 30 is free from this rejection as it does not recite "receptor".

The Examiner further rejected Claim 12 under this section as not supported by the specification for the two components recited in Claim 12. As noted above, Claim 12 is canceled and the rejection is therefore moot as to this claim. New Claim 30 encompasses a labeled antibody or antigen binding portion of the antibody which binds to SEQ ID NO:2 or 4; the polypeptide of SEQ ID NO:2 or 4 attached to a solid support; and instructions for use. All components are fully supported on page 49, lines 6-14, therefore new Claim 30 is free from rejection under this section.

In view of the above, Applicants submit that the rejection of Claim 12 under 35 U.S.C. 112, first paragraph is overcome. Withdrawal of this rejection is respectfully requested.

II. Rejection of Claims 6 and 26 under 35 U.S.C. §102(e).

The Examiner rejected Claims 6 and 26 under 35 U.S.C. §102(e) as anticipated by U.S. Pat. No. 5,457,035 (Baum, et al.). The Examiner alleged that Baum, et al., describes an antibody expected to bind to a short sequence of amino

acids having the same sequence as a short sequence in SEQ ID NO:4 of Claim 6. Applicants respectfully disagree. Applicants submit that Claims 6 and 26 recite antibodies or antigen binding fragments that specifically bind a protein or peptide of SEQ ID NO:2 or 4. Specific binding is defined as "... antibodies raised to the 312C2 of SEQ ID NO:2 or 4 can be selected from to obtain antibodies specifically immunoreactive with that particular protein and not with other proteins." (see, e.g., page 16, lines 28-37, of the Specification, emphasis added). The Specification further provides means for identifying and isolating these antibodies or fragments thereof which specifically bind to SEQ ID NO: 2 or 4.

Applicants submit that the antibodies described by Baum et al. would not specifically bind to the polypeptides of SEQ ID NO: 2 or 4. Thus the cited reference fails to anticipate the claimed antibodies of the present invention.

In view of the foregoing, the rejection of Claims 6 and 26 under 35 U.S.C. 102(e) is overcome. Withdrawal of this rejection is respectfully requested.

### III. Rejection of Claims 6, 23-29 under 35 U.S.C. §103(a).

The Examiner rejected Claims 6, 23-29 under 35 U.S.C. §103(a) as being unpatentable over Baum, et al., supra, in view of Godowski, et al., U.S. Pat. No. 5,709,858 (Godowski, et al.). As noted above, Baum et al. describe antibodies which bind OX40L which share identity over 5 amino acids with the polypeptide of SEQ ID NO: 4. Godowski et al teach various general methods of producing antibodies. As noted above, Baum et al. do not teach antibodies or fragment thereof which specifically binds to SEQ ID NO: 4, and not other proteins. Godowski, et al. fails to cure the deficiencies of Baum, et al.

Applicants submit that one skilled in the art would not arrive at Applicants' invention, with reasonable predictability, using the cited reference. In particular, Baum et al. and Godowski et al. do not teach the skilled artisan how to produce antibodies or binding fragments thereof that specifically bind to SEQ ID NO: 4, and not to bind to other proteins. Applicants further point out that it is improper to use the present disclosure in combination with the cited references in hindsight recreation of the Applicants invention.

In view of the foregoing, the rejection of Claims 6 and 26 under 35 U.S.C. 103(a) as being unpatentable over Baum, et al. and Godowski, et al. is overcome. Withdrawal of this rejection is respectfully requested.

Conclusion

Applicants' current response is believed to be a complete reply to all the outstanding issues of the latest Office Action. Further, the present response is a bona fide effort to place the application in condition for allowance or in better form for appeal. Accordingly, Applicants respectfully request reconsideration and passage of the amended claims to allowance at the earliest possible convenience. Should the Examiner deem allowance inappropriate at this time, Applicants respectfully request an interview be granted with the undersigned to consider any issues.

Respectfully submitted,

Date: November 12, 2002

By:   
Sheela Mohan-Peterson  
Reg. No. 41,201  
Attorney for Applicants

DNAX Research, Inc.  
901 California Avenue  
Palo Alto, California 94304-1104  
TEL: 650-496-1244  
FAX: 650-496-1200